Appl. No. 09/645,645   <u>PATENT</u>
Amdt. dated July 6, 2004
Reply to Office Action of April 5, 2004

<div align="center"><u>REMARKS/ARGUMENTS</u></div>

Amendments

The claims are modified in the amendment. More specifically, claims 1 and 8 have been amended; claim 22 has been cancelled; and new claim 24 has added. Therefore, claims 1-21, 23 and 24 are present for examination. It is noted that claim 22 is rewritten in independent form as claim 1. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

Double Patenting

Claims 1-23 stand as provisionally rejected under 35 U.S. C. §101 the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/728,524. Applicants will address this rejection should Application No. 09/728,524 ever ripen into an issued application.

35 U.S.C. §112 Rejection

Claim 1 is rejected under 35 U.S.C. §112 as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. This claim is amended in such a way that the scope of the claim is unaffected. No new matter is added by this amendment.

35 U.S.C. §103 Rejection, Cotten

The Office Action has rejected claims 1-23 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,330,590 to Cotten (hereinafter "Cotten") in view of the cited portions of U.S. Patent No. 6,460,050 to Pace et al. (hereinafter "Pace"). In their current form, Applicants believe major limitations from claims 1, 8 and 15 are neither taught nor suggested in the Cotten and Pace references. More specifically, none of Cotten and Pace teach or suggest: (1) locating portion steps that are influenced by the content of the electronic mail message as required by amended claim 1; (2) generation of codes and generation of more codes based upon a threshold determination as required by amended claim 8;

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and (3) interrupting the portion selection when a predetermined count is reached as required by claim 15. Applicants respectfully request that the outstanding rejections be withdrawn for at least these reasons.

First Missing Limitation: Locating Portions Based Upon Content

Amended claim 1 (i.e., claim 22 in independent form) requires locating portion steps that are influenced by the content of the electronic mail message. In this way, embodiments of the claimed invention are adaptive according to the particular e-mail message. Contrary to the assertion on page 10, first full paragraph of the Office Action, Applicants can find no teaching or suggestion in Pace that changes the locations when finding portions for a particular message. Pace does teach selecting different portions, but there is no appreciation in Pace that this could be done on a per message basis. For example, Pace might always decide to use the subject line and would do so for each message encountered. For at least this reason, reconsideration of amended claim 1 is respectfully requested.

Second Missing Limitation: Locating Portions Based Upon Content

Amended claim 8 requires generation of codes and generation of more codes based upon a threshold determination. The Office Action takes the position that a threshold is implicit in Pace. Office Action, page 8, last full paragraph. Clearly, Pace cannot also implicitly require generation of more codes based upon an implicit threshold determination as is currently claimed. In one embodiment of the claimed invention, a first algorithm is used before resorting to a second algorithm if that proves to yield too few codes. Application, FIG. 6B, steps 640, 644 and 648. Reconsideration of the rejection is respectfully requested.

Third Missing Limitation: Locating Portions Based Upon Content

Claim 15 requires interrupting the portion selection when a predetermined count is reached. The Office Action takes the position that a threshold is implicit in Pace. <u>Office Action</u>, page 8, last full paragraph. If Applicants follow this argument, Pace determines what is spam after a threshold is met. <u>Pace</u>, col. 6, lines 37-42.

It does not necessarily follow that the selection process is interrupted once a threshold is met. Pace measures a "frequency," not a threshold frequency that would stop further analysis. Taking Pace at face value, Pace would say a word appeared "x" number of times in a particular message and could later determine if "x" exceeded a threshold. For example, it may find the word ten times and later decide this exceeds the threshold of five. In contrast, the claimed invention in one embodiment would stop selecting the particular word after the threshold of five is reached. The claimed invention could avoid finding the remaining five occurrences. When processing millions of messages, this invention can significantly increase performance in one embodiment. For at least this reason, reconsideration of amended claim 15 is respectfully requested.
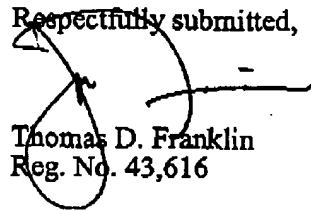
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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       If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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